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9/25/07

In re Application of:
MARTIN BRADY, et al.
Serial No.: 09/228109
Filed: Jan. 11, 1999
Docket: 0166
Title: UNIVERSAL CLEAT

DECISION ON PETITION
TO WITHDRAW DRAWING
OBJECTION

This is a decision on the petition filed on July 25, 2007 seeking reversal of the drawing objection under 37 CFR 1.83(a). The petition is being considered pursuant to 37 CFR 1.181. No fee is required.

The petition is **DISMISSED**.

In the petition, the petitioner requests a review of the examiner's objection to the drawings under 37 CFR 1.83(a). The examiner objected to the drawing on the grounds that "the housing comprising a holder and a sheath" recited in claims 11 and 13 were not illustrated. Petitioner believes that the objection to the drawings is in error and requests review and relief therefrom.

The record shows that:

- 1) In a Non-Final Rejection on October 11, 2006, Examiner rejected claims 11 and 13 under 35 U.S.C. 112, second paragraph, because the phrase "a sheath" was unclear (Page 4). Examiner states, "It is unclear if claims 11 and 13 intended for the "scissors holder" to further comprise a sheath or if the term "a sheath" represents an additional structure.
- 2) Applicants responded on March 12, 2007 stating that claims 11 and 13, "adequately define the invention to one who is familiar with the disclosure." Applicants emphasized that the application, "was thoroughly and repeatedly examined" before Examiner raised the current 35 U.S.C. 112 rejection towards claims 11 and 13.
- 3) On May 25, 2007, Examiner issued a Final Rejection, objecting to the drawing on the grounds, "The drawings must show every feature of the invention specified in the

claims...’the housing comprising a holder and a sheath’, of claims 11 and 13, must be shown or the feature(s) canceled from the claim(s)... “ (Page 2). Examiner repeated that claims 11 and 13 were rejected under 35 U.S.C. 112, second paragraph, because the phrase “a sheath” was unclear (Page 3).

4) On Jul. 25, 2007, the current petition seeking withdrawal of the drawing objection under 37 CFR § 1.83(a)¹ was filed.

Discussion and Analysis

A review of the record indicates that the drawing objection and claim rejection are directed to the same issues. In the final Office action of May 25, 2005, the rejection of claims 11 and 13 under 35 USC 112, 2nd Paragraph, the examiner stated the phrase “a sheath” is not clear. The examiner also objected to the drawing that the subject matter of claims 11 and 13 is not shown by the original drawings. That is, the correctness of Examiner’s drawing objection, resting on the lack of clarity of, ‘the housing comprising a holder and a sheath,’ is dependent on the correctness of Examiner’s 35 USC 112 rejection of claims 11 and 13 based on the phrase “a sheath.” It is the policy of the USPTO in appropriate circumstances to decline to rule on a petitionable issue, when, as here, that an issue is also determinative of a rejection, and as such, is appropriate for consideration on appeal to the BPAI. In this case, the issue in the objection and rejection, as here, additionally and necessarily requires the exercise of technical skill and legal judgment in order to evaluate the facts presented, the issue is properly decided on the merits, and is properly reviewed on appeal, not petition. Under the circumstances, it is believed that the issues presented under the claim rejections and drawing objection in the instant case require the same review by the BPAI. Thus, this issue is appealable and should not be decided by petition.

Conclusion

For the foregoing reasons, the relief requested by the petitioner will not be granted. Because there is both an objection to drawings under 37 CFR 1.83(a) and a rejection to claims 11 and 13 under 35 USC 112, 2nd paragraph, and both the correctness of the objection and the rejection depend on the same issue, the issue is an appealable one and will not be decided by petition.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3724 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No

¹ § 1.83 Content of drawing. (a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Marc Jimenez, Training Quality Assurance Specialist, at (571) 272-4530.

PETITION DISMISSED

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for
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